



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/816,990

04/01/2004

Deverakonda S. Sarma

P26,754-A USA

2016

23307 7590 05/13/2008
SYNNESTVEDT & LECHNER, LLP
1101 MARKET STREET
SUITE 2600
PHILADELPHIA, PA 19107-2950

EXAMINER

FAISON GEE, VERONICA FAYE

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

05/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/816,990	Applicant(s) SARMA, DEVERAKONDA S.	
	Examiner VERONICA FAISON GEE	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 10-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinton (US Patent 5,344,483).

Hinton teaches an ink composition suitable for ink jet printing is made from a fatty acid ester base and a diluent. The base is combined with a compatible diluent, such as an alcohol having a low-viscosity and low vapor pressure to provide an ink composition (abstract). The reference further teaches that the base consists essentially of a fatty acid which is liquid at room temperature, a polyalkylene glycol, and a dye which is combined with the fatty acid to form an ester (col. 1 line 66-col.2 line 3). The reference also discloses a process for making an ink jet ink composition of the following steps 1). forming a mixture of a fatty acid which is liquid at room temperature, a polyalkylene glycol, and a dye capable of reacting with the fatty acid to form an ester, 2). Heating the resulting mixture to a temperature sufficient to cause the dye and fatty acid to react to form the ester and for a time sufficient to drive off excess water from the mixture, and then 3). Combining the mixture with the diluent to form the ink composition (col. 3 line 58-col. 4 line 5). The diluent is an alcohol such as glycol ether including diethylene glycol ether and aromatic alcohols such as benzyl alcohol (col. 4 lines 20-32). The

Art Unit: 1793

reference discloses that oleate (fatty acid) bases are widely used in the ink industry as a means of solvating dyes and producing liquid colorants that can be augmented and used in a variety of printing applications including writing and printer ribbon inks.

Because the invention of the reference is to replace oleate bases, due to some undesirable characteristics, one of ordinary skill in the art would conclude that the fatty acid base of the reference could also be used in other printing applications such as a printer ribbon ink absence tangible evidence to the contrary.

Claim 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinton (US Patent 5,344,483) as applied to claims 1-3 and 6-9 above, and further in view of Woolf (US Patent 5,897,694).

Hinton is described above, but fails to teach water and other additives.

Woolf teaches an ink jet ink composition comprising diluent system and colorant. The reference further teaches that the diluent system may be aqueous or nonaqueous and that the aqueous diluent may comprise water and other solvents such as glycol ethers (col. 2 lines 4+). The composition further may comprises additives such as a corrosion inhibitor and pH adjusting agent including sodium hydroxide which is well known in the art as an additive that is present in compositions (col. 6 lines 56-64).

Therefore it would have been obvious to one of ordinary skill in the art to the aqueous diluent as taught by Woolf in the Hinton composition, because the water and glycol combination would be compatible with the base of Hinton absence tangible evidence to the contrary.

Response to Arguments

Applicant's arguments filed 6-22-07 have been fully considered but they are not persuasive.

Applicant argues that the method of the reference does not contain a teaching of a certain viscosity or is "suitable for application to a substrate using an impact printing technique" and that the actual teaching of Hinton which clearly indicated that the invention is directed to "an ink composition suitable for ink jet printing".

The preamble limitation "suitable for application to a substrate using an impact printing technique" is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 USPQ 6411.

Hinton discloses that oleate (fatty acid) bases are widely used in the ink industry as a means of solvating dyes and producing liquid colorants that can be augmented and used in a variety of printing applications including writing and printer ribbon inks. Printing ribbon inks as shown by Jou et al (US 2004/0055484) has a viscosity that encompasses Applicant's claimed range. Therefore, even though the reference remains silent to the particular viscosity of the base Jou et al shows that the particular type of ink would have a viscosity in Applicant's claimed range.

Applicant requested a suspension of examination for three months to generate data supporting the patentability of the claimed invention.

The request for suspension was granted, however applicant has not submitted any data to overcome the rejections and therefore the rejections have been maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **VERONICA FAISON GEE** whose telephone number is (571)272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/
Supervisory Patent Examiner, Art Unit 1793

/V. F. G./
Examiner, Art Unit 1793
5-9-08